

Application No. 10/629,441  
Amendment dated July 29, 2005  
Reply to Office Action of May 4, 2005

## **REMARKS**

### **Status Of Application**

Claims 1-52 were pending in the application. By this amendment, claims 22 and 48 are canceled and new claims 53-60 are added. The status of the claims is as follows:

Claims 10, 13, 36, and 39 are rejected under 35 U.S.C. § 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claims 1-5, 7, 9, 12, 27-31, 33, 35, and 38 are rejected under 35 U.S.C. § 102(b) as being clearly anticipated by U.S. Patent No. 6, 040,949 to Ohno ("Ohno").

Claims 1-5, 7, 12-18, 20, 25-31, 33, 38-44, 46, 51, and 52 (the Office Action states that 1-5, 7, 12-18, 20, 25-31, 33, 38-44, 46, 51, and 51 are rejected) are rejected under 35 U.S.C. § 102(e) as being clearly anticipated by U.S. Patent No. 6,865,026 B2 to Nozawa, et al. ("Nozawa").

Claims 6, 8, 19, 21, 24, 32, 34, 45, 47, and 50 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

Claims 10 and 36 would be allowable if written to overcome the rejection(s) under 35 U.S.C. § 112, second paragraph, set forth in this Office Action and to include all of the limitations of the base claim and any intervening claims.

Please note that a Supplemental Information Disclosure Statement, along with a PTO Form 1449, is being filed concurrently.

**Specification Amendments**

Original paragraph [0019] has been amended to correct a typographical error, and thus introduces no new matter.

Original paragraph [0044] indicated  $m_{2w}$  and  $m_{2t}$  represented the imaging magnification of the second lens unit at the wide-angle end W and telephoto end T, respectively. However, a review of the specification and the figures shows the imaging magnification of the second lens unit cannot change as a function of position. In other words,  $m_{2w}$  would equal  $m_{2t}$ , an obvious error that one of skill in the art would readily discern. In fact,  $m_{2w}$  and  $m_{2t}$  should correspond to the imaging magnification of the zoom lens system with the second lens unit at the wide-angle end W and telephoto end T, respectively. Such a change is in harmony with the specification and the figures, which show that the imaging magnification would be different at the wide-angle end W and the telephoto end T. In particular, paragraph [0043] notes “the second lens unit GR2 increases the magnification, and the second lens unit GR2 decreases it,” i.e., the second lens unit changes the magnification. The reason for the difference in imaging magnification is that the second lens unit changes position between the wide-angle end W and telephoto end T, *see* Figs. 1-5. For this reason, the amendments to paragraph [0044] do not introduce any new matter.

**Claim Amendments**

Claims 1 and 27 have been amended to require that the first lens unit include “a cemented lens element, the cemented lens element including a negative lens element and a positive lens element.” Support for this limitation is found in paragraph [0052] and is illustrated in Figs. 1, 2, and 5. Thus, these changes do not introduce any new matter.

Claims 14 and 40 have been amended to include the limitations of dependent claims 22 and 48, respectively. These changes do not introduce any new matter.

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Claims 10, 13, 36, and 39 have been amended to more clearly define their terms. These changes are not necessitated by the prior art, are unrelated to the patentability of the invention over the prior art, and do not introduce any new matter.

#### **New Claims**

By this amendment, new claims 53-60 have been added. Claim 53 finds support in paragraphs [0014], [0016], [0019], [0049], and [0050]. Claim 54 finds support in paragraph [0022] and Figs. 1-4. Claim 55 finds support in paragraph [0022] and Figs. 5 and 10. Claim 56 finds support in paragraph [0022] and Figs. 1-4. Claim 57 finds support in paragraph [0022] and Fig. 5. Claim 58 finds support in paragraphs [0035]-[0038]. Claim 59 finds support in paragraph [0044]. Claim 60 finds support in paragraph [0023]-[0027] and Figs. 1-10. Because support for each of these claims is found in the original application, claims 53-60 do not introduce any new matter.

#### **35 U.S.C. § 112 Rejection**

The rejection of claims 10, 13, 36, and 39 under the second paragraph of 35 U.S.C. § 112 as being indefinite for failing to particularly point out and distinctly claim the subject matter which Applicant regards as the invention, is respectfully traversed based on the following.

Claims 10, 13, 36, and 39 have been amended to more clearly define their terms, thereby overcoming the indicated antecedent basis errors.

Accordingly, it is respectfully requested that the rejection of claims 10, 13, 36, and 39 under the second paragraph of 35 U.S.C. § 112 as being indefinite for failing to particularly point out and distinctly claim the subject matter which Applicant regards as the invention be reconsidered and withdrawn.

**35 U.S.C. § 102(b) and (e) Rejections**

The rejection of claims 1-5, 7, 9, 12, 27-31, 33, 35, and 38 under 35 U.S.C. § 102(b) as being clearly anticipated by Ohno, is respectfully traversed based on the following.

Amended claim 1 requires, in part, that the first lens unit include “a cemented lens element, the cemented lens element including a negative lens element and a positive lens element.” This cemented lens element is clearly illustrated in Figs. 1, 2, and 5, being of the correct negative/positive lens element configuration.

In contrast, Ohno does not disclose such a cemented lens element as part of a first lens unit. In fact, each first lens unit disclosed by Ohno includes only one single lens element. Therefore, Ohno does not disclose a cemented lens element as part of a first lens unit, let alone one that is of the required negative/positive lens element configuration. Because Ohno does not disclose every limitation of claim 1, Ohno cannot anticipate claim 1. Claims 2-5, 7, 9, 11, and 12 depend from unanticipated claim 1 and are unanticipated for at least the same reasons.

Claim 27 has similarly been amended to require that the first lens unit include a cemented lens element of a negative/positive lens element configuration. As noted above, Ohno does not disclose a first lens unit that includes a cemented lens element of the correct negative/positive lens element configuration. Because Ohno does not disclose every limitation of claim 27, Ohno cannot anticipate claim 27. Claims 28-31, 33, 35, and 38 depend from unanticipated claim 27 and are unanticipated for at least the same reasons.

Accordingly, it is respectfully requested that the rejection of claims 1-5, 7, 9, 12, 27-31, 33, 35, and 38 under 35 U.S.C. § 102(b) as being clearly anticipated by Ohno, be reconsidered and withdrawn.

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The rejection of claims 1-5, 7, 12-18, 20, 25-31, 33, 38-44, 46, 51, and 52 under 35 U.S.C. § 102(e) as being clearly anticipated by Nozawa, is respectfully traversed based on the following.

While Nozawa discloses a first lens unit that includes multiple lens elements, Nozawa does not disclose a cemented lens element. Because Nozawa does not disclose a cemented lens element as part of a first lens unit, Nozawa cannot disclose a cemented lens element that is of the required negative/positive lens element configuration. Because Nozawa does not disclose every limitation of claim 1, Nozawa cannot anticipate claim 1. Claims 2-5, 7, 12, and 13 depend from unanticipated claim 1 and are unanticipated for at least the same reasons.

Amended claim 27 similarly requires that the first lens unit include a cemented lens element of a negative/positive lens element configuration, which is not disclosed by Nozawa. Because Nozawa does not disclose every limitation of claim 27, Nozawa cannot anticipate claim 27. Claims 28-31, 33, 38, and 39 depend from unanticipated claim 27 and are unanticipated for at least the same reasons.

The Office Action notes that original dependent claims 22 and 48 would be allowable if rewritten in independent form. Accordingly, independent claims 14 and 40 have been amended to include the limitations recited in original dependent claims 22 and 48, respectively. For this reason, claims 14 and 40 are considered unanticipated by Nozawa. Claims 15-18, 20, 25, and 26 depend from unanticipated claim 14 and are unanticipated for at least the same reasons. Claims 41-44, 46, 51, and 52 depend from unanticipated claim 40 and are unanticipated for at least the same reasons.

Accordingly, it is respectfully requested that the rejection of claims 1-5, 7, 12-18, 20, 25-31, 33, 38-44, 46, 51, and 52 under 35 U.S.C. § 102(e) as being clearly anticipated by Nozawa, be reconsidered and withdrawn.

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### **CONCLUSION**

In view of the foregoing, this application is considered to be in condition for allowance, and an early reconsideration and a Notice of Allowance are respectfully requested.

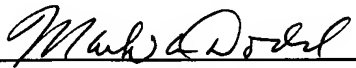
This Amendment increases the number of independent claims by 1 from 4 to 5 and increases the total number of claims by 6 from 52 to 58, but does not present any multiple dependency claims. Separately, if an extension of time is required to enable this document to be timely filed and there is no separate Petition for Extension of Time filed herewith, this document is to be construed as also constituting a Petition for Extension of Time Under 37 C.F.R. § 1.136(a) for a period of time sufficient to enable this document to be timely filed.

Accordingly, a Response Transmittal and Fee Authorization form authorizing the amount of \$500.00 to be charged to Sidley Austin Brown & Wood LLP's Deposit Account No. 18-1260 is enclosed herewith in duplicate. However, if the Response Transmittal and Fee Authorization form is missing, insufficient, or otherwise inadequate, or if any fee

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pursuant to 37 C.F.R. §§ 1.16 and 1.17, other than the issue fee, is required by this response, please charge such fee to Sidley Austin Brown & Wood LLP's Deposit Account No. 18-1260. Any refund should be credited to the same account.

Respectfully submitted,

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